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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,480	12/18/2001	Timothy David Warlick		9218

7590 01/19/2005  
Timothy Warlick  
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EXAMINER

SAFAVI, MICHAEL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/020,480	WARLICK, TIMOTHY DAVID	
	Examiner	Art Unit	
	M. Safavi	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on September 15, 2003 & November 15, 2004.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>September 15, 2003</u> . | 6) <input type="checkbox"/> Other: _____  |

***Specification***

The amendment filed September 15, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Language within the newly submitted Abstract, or Title:Summary, presents language and concepts not previously presented within the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action. Further, it is not clear as to what the newly presented "Title:Summary" supplements or replaces since no instruction or indication is given as to such paper.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification had not originally presented any of the following limitations recited within the claims: "said weight being longitudinally solid"; "...including external and internal surfaces"; "said apertures located

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...perpendicular to the horizontal plane length of said weight"; "said weight having a height in excess of the length of said apertures"; "said apertures having a length in excess of the width of a diver's belt" or "said apertures having a length in excess of the width of a diver's belt (supplied by others)"; "said apertures having a width in excess of the thickness of said diver's belt"; "said apertures in nearly equal distant spacing as is aesthetically or practically desired"; "said weight having thickness of one fourth of the height of said weight"; "the desired height of said weight determined by dimensional adjustment of one or more axes"; "until three or more said apertures or total apertures thereof are in containment"; "frictional". None of the above quoted phrases or limitations find support within the original disclosure.

Further, it is not understood as to what is being defined by any of the above phrases or limitations since the specification does not appear to provide antecedent basis or support for any of the above terms phrases or limitations. For example, the specification fails to recite "longitudinally solid" or "external and internal surfaces" or "encompassing" or "horizontal plane length" or "height" or "excess" or "length" or "width" or "supplied" or "others" or "thickness" or "nearly equal distant spacing" or "as is aesthetically or practically desired" or "height" or "one fourth" or "dimensional adjustment" or "axes" or "containment" or "frictional".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12, line 3, it is not clear as to what is being defined by "said weight encompassing three or more belt receiving through apertures". What, specifically, is being defined by "encompassing"? Further, it is not clear as to what is being defined by any of the following limitations recited within claim 12: "said weight being longitudinally solid"; "...including external and internal surfaces"; "said apertures located ...perpendicular to the horizontal plane length of said weight"; "said weight having a height in excess of the length of said apertures"; "said apertures having a length in excess of the width of a diver's belt" or "said apertures having a length in excess of the width of a diver's belt (supplied by others)"; "said apertures having a width in excess of the thickness of said diver's belt"; "said apertures in nearly equal distant spacing as is aesthetically or practically desired"; "said weight having thickness of one fourth of the height of said weight"; "the desired heft of said weight determined by dimensional adjustment of one or more axes". None of the above quoted phrases or limitations find support within the original disclosure. What, specifically, is being defined by "(supplied by others)"? Is the language of claim 12 directed to an old and well-known device?

Claim 13, it is not clear as to what is being defined by "until three or more said apertures or total apertures thereof are in containment" or "introducing a frictional non slip environment". Neither of the above quoted phrases or limitations find support within

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the original disclosure. Further, it is not clear as to whether the language of claim 13 defines a weight per se or a weight attached to a belt.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selisky in view of Walsh, Jr. Selisky discloses, Fig. 1, a weight 10 formed of lead with any number of weight being utilized on a diving belt 23 while Walsh, Jr. discloses, Fig. 9, a "ballast" or pad 22 woven on a belting material 25 and possessing more than two belt receiving slots so as to allow for a firm positioning of the "ballast" or pad upon the belting material. To have formed the Selisky weight with more than two belt receiving slots, thus assuring a firm positioning of the Selisky "ballast" 10 upon the belting material 23, would have constituted an obvious expedient to one having ordinary skill in the art at the time the invention was made as taught by Walsh, Jr.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finnern in view of Walsh, Jr. Finnern discloses, Fig. 2, a weight 50 formed of lead with any number of weight being utilized on a diving belt 10 while Walsh, Jr. discloses, Fig.

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9, a "ballast" or pad 22 woven on a belting material 25 and possessing more than two belt receiving slots so as to allow for a firm positioning of the "ballast" or pad upon the belting material. To have formed the Finnern weight with more than two belt receiving slots, thus assuring a firm positioning of the Finnern "ballast" 50 upon the belting material 10, would have constituted an obvious expedient to one having ordinary skill in the art at the time the invention was made as taught by Walsh, Jr.

### ***Response to Arguments***

Applicant's arguments filed September 15, 2003 have been fully considered but they are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The modification of Selisky is suggested by Walsh, Jr. as had been set forth in the above rejection involving Selisky and Walsh, Jr. Contrary to Applicant's assertions at lines 25-26 on page 7 of the response, Walsh does disclose the "pad" 22 as part of a ballast as at col. 8, lines 25-35 and lines 41-44. And, by its very nature the Walsh, Jr. pad" 22 serves as a ballast since it provides weight and rigidity, col. 8, line 26-28 of Walsh, Jr. Thus, Walsh, Jr. serves to teach forming the Selisky weight with three or more apertures allowing the Selisky belt to be weaved there through while assuring a firm positioning of the Selisky "ballast" 10 upon the belting material 23. Likewise, Walsh, Jr. serves to teach forming the Finnern weight with three

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or more apertures allowing the Finnern belt to be weaved there through while assuring a firm positioning of the Finnern "ballast" 50 upon the belting material 10.

As for Applicant's arguments at lines 4-7 on page 7 of the response, the modification of either Selisky or Finnern does not destroy or render non-operable either of the Selisky or Finnern devices. Rather, the proposed modification of Selisky and Finnern serves to establish a secure fitting between the respective ballast and belt.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2481.

The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**MICHAEL SAFAVI  
PRIMARY EXAMINER  
ART UNIT 354**

M. Safavi  
January 10, 2005